

REMARKS/ARGUMENTS

No claims are amended, added, or canceled by this Amendment. (Claims 1-42 and 59-86 were previously canceled.) Claims 43-58 remain pending in this application. Applicants respectfully request reexamination and reconsideration of the application.

Claims 43-58 were rejected under the judicially created doctrine of obvious-type double patenting in view of claims 1-40 of US Patent No. 6,640,415 (hereinafter "the '415 patent").

Applicants respectfully traverse this rejection on the grounds that claims 43-58 in the instant application and the claims from which claims 1-40 of the '415 patent issued were the subject of a restriction requirement during prosecution of US patent application serial no. 09/327,116, which is a parent application to both the instant application and the '415 patent. (US patent application serial no. 09/327,116 is hereinafter referred to as the "Parent Application.")

More specifically, the Parent Application was filed on June 7, 1999 with 83 claims. On January 18, 2001, the PTO issued a restriction requirement (hereinafter the "Restriction Requirement") in the Parent Application, identifying five groups of claims as drawn to patentably distinct inventions: Group I, consisting of claims 1-42; Group II, consisting of claim 54-57; Group III, consisting of claims 43-53; Group IV, consisting of claim 58; and Group V, consisting of claims 59-86. Group I was further divided into the following patentably distinct species: Species A, consisting of claims 1-10; Species B, consisting of claims 11-25; and Species C, consisting of claims 26-42. (A copy of the Restriction Requirement is attached hereto in Appendix A, and a copy of the claims as originally filed in the Parent Application is attached in Appendix B.)

Applicants elected the claims of Group V for prosecution in the Parent Application, and Applicants filed the '415 patent and the instant application as divisional applications. The '415 patent was filed with the claims of Group I, and the instant application was filed with the claims of Groups II-IV. Because the claims of the '415 patent and the claims of the instant application were the subject of the Restriction Requirement in the Parent Application and were thus found to be drawn to patentably distinct inventions, those claims cannot now be rejected on the grounds of obvious-type double patenting. (35 USC § 121.)

Applicants note that the claims that issued from the '415 patent are consonant with the Restriction Requirement. For example, claims 1 and 25 as issued in the '415 patent correspond to claims 8 and 40 as originally filed in the Parent Application and were classified in Group I of

the Restriction Requirement. In contrast, claim 43 of the instant application (which corresponds to claim 43 as originally filed in the Parent Application) was classified in Group III of the Restriction Requirement and therefore found to be patentably distinct from claims 8 and 40 (now claims 1 and 25 of the '415 patent). Having found for purposes of the Restriction Requirement that the claims of the '415 patent are patentably distinct from the claims of the instant application, the PTO cannot now find the reverse for purposes of a double patenting rejection. For this reason alone, the double patenting rejection must be withdrawn.

Applicants further traverse the double patenting rejection on the additional grounds that the Office Action does not set forth a *prima facie* case of obviousness. As set forth in the MPEP:

"Any obviousness-type double patenting rejection should make clear:

(A) The difference between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and

(b) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent." (MPEP § 804, pg. 800-22, subsection entitled "1. Obvious-Type.")

Thus, as with any rejection based on obviousness, to establish a *prima facie* case, the Office Action must (1) identify differences between the claims of the prior application and the claims being rejected in the instant application and (2) explain why those differences are obvious.

Here, the Office Action does not identify the differences between claims 1-40 of the '415 and the claims of the instant application, nor does the Office Action explain why a person of ordinary skill in the art would conclude that such differences are obvious. For this additional reason—that the Office Action does not set forth a *prima facie* case of obviousness—the double patenting rejection must be withdrawn.

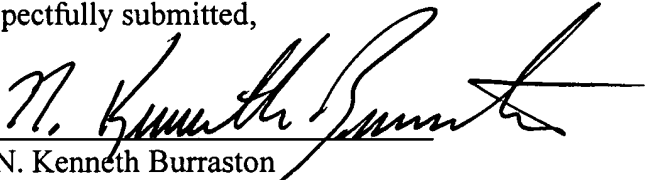
Applicants note that Information Disclosure Statements were filed on September 23, 2003 and June 21, 2005 and a third Information Disclosure Statement is filed with this Response. Applicants request that the lists of references filed with each of those three Information Disclosure Statements be initialed and returned.

In view of the foregoing, Applicants submit that all of the claims are allowable and the application is in condition for allowance. If the Examiner believes that a discussion with Applicants' attorney would be helpful, the Examiner is invited to contact the undersigned at (801) 323-5934.

Respectfully submitted,

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